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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,719	01/03/2002	Thomas E. Creamer	BOC9-2000-0061 (196)	8949
40987	7590	10/04/2005	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER

2145

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

10/038,719

Applicant(s)

CREAMER ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-6, 8-10, 12, 14, 17-20, 24-25, 27-29, 31, 33, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al. (U.S. Pub. No. 2002/0023131).

3. In regard to claim 1, Wu discloses *inserting in an instant message (IM) a voice conference identifier comprising a voice conference call list identifying conference call nodes; transmitting said IM from a sender to a recipient at a recipient node; a recipient client detecting the voice conference identifier within the IM; responsive to the detecting step, an IM interface of the recipient displaying a user-selectable text or graphic symbol; and responsive to a user-selection of said displayed text or graphic symbol, automatically establishing a voice communication link between the recipient and the sender.* See Wu, paragraphs 0066-0074, where a user can send a request to initiate a peer-to-peer audio session over instant messenger and a recipient can allow the conversation by selecting a "START TALK" UI button and thereafter establishing said session.

4. In regard to claim 5, Wu is applied as in claim 1. Wu further discloses *said voice conference call list specifies IP addresses for said identified conference call nodes.* The IP address is indicated in paragraph 0071.

5. In regard to claim 6, Wu is applied as in claim 1. Wu further discloses *inserting in said IM/chat message a selectable symbol for initiating said voice communication link with said selected ones of said identified conference call nodes.* See the START TALK UI with a START TALK button in paragraphs 0069-0075 of Wu.

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6. In regard to claim 8, Wu is applied as in claim 1. Wu further discloses *embedding computer program code in said IM/chat message, wherein said computer program code is executed responsive to a user selection of said displayed text or graphic symbol, wherein execution of said computer program code establishes said voice communication link*. The selection of a graphic symbol is the START TALK UI button described in paragraphs 0069-0075. The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code is in paragraphs 0071-0074.

7. Claim 9 has substantially the same limitations as claim 1. Therefore, the rejection of claim 1 is equally applicable against claim 9.

8. In regard to claim 10, Wu is applied as in claim 9. Wu further discloses *said displaying step displays a single icon and said establishing step establishes said voice conference call between said selected ones of said identified conference call nodes responsive to said selection of said single icon*. See Wu, paragraph 0074.

9. In regard to claim 12, Wu is applied as in claim 9. Wu further discloses *extracting from said IM embedded software program*. The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code is in paragraphs 0071-0074.

10. Claim 14 has substantially the same limitations as claim 5. Therefore, the rejection of claim 5 is equally applicable against claim 14.

11. In regard to claim 17, Wu is applied as in claim 9. Wu further discloses *responsive to said selection of said at least one icon, determining a telephone number or an IP address for said selected ones of said identified conference call nodes based on said voice conference call list*. Wu establishes the talk session based on selection of an icon in paragraph 0074. The icon identifies appropriate IP addresses as shown in paragraph 0071.

12. Claim 18 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 18.

13. In regard to claim 19, Wu is applied as in claim 18. The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code, or *said*

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software program, which is embedded within the instant message for purposes of establishing a voice communications link, is in paragraphs 0071-0074.

14. Claim 20 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 20.

15. Claim 24 has substantially the same limitations as claim 5. Therefore the rejection of claim 5 is equally applicable against claim 24.

16. Claim 25 has substantially the same limitations as claim 6. Therefore the rejection of claim 6 is equally applicable against claim 25.

17. Claim 27 has substantially the same limitations as claim 8. Therefore the rejection of claim 8 is equally applicable against claim 27.

18. Claim 28 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 28.

19. Claim 29 has substantially the same limitations as claim 6. Therefore the rejection of claim 6 is equally applicable against claim 29.

20. In regard to claim 31, Wu is applied as in claim 28. Wu further discloses *extracting from said IM embedded software program*. The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code is in paragraphs 0071-0074.

21. Claim 33 has substantially the same limitations as claim 5. Therefore the rejection of claim 5 is equally applicable against claim 33.

22. In regard to claim 36, Wu is applied as in claim 28. Wu further discloses *responsive to said selection of said at least one icon, determining a telephone number or an IP address for said selected ones of said identified conference call nodes based on said voice conference call list*. Wu establishes the talk session based on selection of an icon in paragraph 0074. The icon identifies appropriate IP addresses as shown in paragraph 0071.

23. Claim 37 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 37.

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Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 3-4, 13, 16, 22-23, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Hanson et al. (U.S. Patent No. 6,697,474).

26. In regard to claims 3, 16, 22, and 35, Wu is applied as in claims 1, 9, 20, and 28. Wu fails to disclose the establishment of a voice communications link over a PSTN network. However, Hanson in the same field of endeavor discloses establishing a telephone call via an instant message by utilizing the public switched telephone network. See Hanson, figure 1, column 3, lines 23-24, column 9, lines 11-42. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Wu invention with the teachings of Hanson for the purpose of decreasing costs for a user (Hanson, column 1, lines 39-47). Wu gives motivation by stating that service providers are attempting to provide additional services to instant messaging users (paragraph 0003-0004) and stating that the talk tool in Wu is similar to a telephonic session (paragraph 0084) and may support additional functionality (paragraph 0082).

27. In regard to claims 4, 13, 23, and 32, Wu is applied as in claims 1, 9, 20, and 28. Wu fails to disclose establishing the link between a user and their telephone number for making a voice call. However, Hanson in the same field of endeavor discloses this feature in Figure 4A. The motivation for the combination of Wu and Hanson has been previously stated.

28. Claims 2, 15, 21, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Bogard (U.S. Patent No. 6,757,365).

29. In regard to claim 2, Wu is applied as in claim 1. Wu fails to disclose the use of VOIP for initiating a voice communication link. However, Bogard in the same field of endeavor discloses the use of voice over Internet Protocol to initiate a voice communication link. See Bogard, column 5, lines 42-54. It would have been obvious to one of ordinary skill in the art to modify the Wu invention with the teachings of

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Bogard in order to allow an alternate method of voice communications. Motivation exists to combine Wu and Bogard in the fact that Wu is a version of the instant messenger program created by America Online and Bogard is designed to assist and modify instant messenger programs such as AOL Instant Messenger (Bogard, column 1, lines 13-24) which is taught by Wu (paragraphs 0003-0004).

30. Claims 15, 21, and 34 have substantially the same claim limitations as claim 2 and the rejection of claim 2 is equally applicable against all claims herein mentioned.

31. Claims 7, 11, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu.

32. In regard to claim 7, Wu is applied as in claim 1. In the rejection of claim 6, it has been shown that Wu has the ability to implement a single icon to assist in launching a voice communications link through an instant message. It would be obvious to one of ordinary skill in the art that if a single icon to perform said functionality can be implemented in the Wu invention, that a plurality of icons could likewise be implemented in the Wu invention.

33. Claims 11, 26, and 30 have substantially the same claim limitations as claim 7. Therefore the rejection against claim 7 is equally applicable against all claims herein mentioned.

Terminal Disclaimer

34. The terminal disclaimer filed on 7/21/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the copending applications listed on the terminal disclaimer has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

35. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

36. Applicant's amendments have overcome the rejections under 35 U.S.C. 101.

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Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roskowski et al.	U.S. Pub. No. 2002/0023134
Enete et al.	U.S. Pub. No. 2003/0208543
Diamente et al.	U.S. Pub. No. 2002/0071539
Dworkin	U.S. Pub. No. 2002/0071540
Pennock et al.	U.S. Patent No. 6,807,562
Zondervan et al.	U.S. Pub. No. 2002/0059073
Turner et al.	U.S. Pub. No. 2003/0018725

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Jha' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'Rupal Dharia' in a stylized script.

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER